

REMARKS

A. Status of Claims

Favorable reconsideration of this application, as presently amended, is respectfully requested. Claims 1-26, 36, and 40-52 have previously been cancelled, and Claim 35 is now cancelled. Claims 27-34, 37-39, and 53-65 are currently pending. Claims 31-32, 34, and 64 have been withdrawn from consideration as being drawn to a non-elected invention.

B. Procedural Matters

Applicants gratefully acknowledge the Examiner's statement at page 2 of the present Office Action that the prior rejection of Claims 54 and 63 under 35 U.S.C. § 112, second paragraph, has been withdrawn because of the amendments filed in Applicants' prior response of February 26, 2009.

Applicants also gratefully acknowledge the Examiner's statement at page 5 of the present Office Action that the prior rejection of Claims 27-30, 33, 35, 37-39, 53-59, 63, and 65 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,472,757 to Ogawa has been withdrawn because of the amendments filed in Applicants' prior response of February 26, 2009.

C. Amendments to the Claims

Each of Claims 27-30, 33, 37-39, 53-59, 63, and 65 have been amended to delete the term "uncoated."

Claim 27 has also been amended to recite that the holdout layer comprises a starch sizing agent. Support for this amendment to Claim 27 may be found in, for example, paragraph [0014] of the published version (U.S. Appln. No. 2004/0084163, published May 6, 2004) of the above application.¹

Claim 58 has been amended to recite that the base layer comprises two surfaces and wherein the holdout layer contacts each of the two surfaces of the base layer. Support for these

¹ All further references to the above application will be with respect to published U.S. Appln. No. 2004/0084163.

amendments to Claim 58 may be found in, for example, paragraph [0014] of the above application.²

D. Response to Rejection of Claim 58 under 35 U.S.C. § 112, First Paragraph, for Failing to Comply with the Written Description Requirement

At pages 2-3 of the present Office Action, Claim 58 has been rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the “written description” requirement. This rejection is respectfully traversed with respect to this Claim, as amended:

In support of the rejection of Claim 58 under 35 U.S.C. § 112, first paragraph, the present Office Action makes the following allegation:

Allegation 1: The subject matter of claim 58 was not in the specification or claims as filed. The examiner cannot find where it is stated that the holdout layer contacts **at least** two surfaces of the base layer (emphasis added). Figures 1-3 do not support this statement. The applicant is requested to cancel all new matter.³

Responsive to Allegation 1, Claim 58 has been amended to recite that the base layer comprises two surfaces and wherein the holdout layer contacts each of the two surfaces of the base layer. The subject matter of amended Claim 58 is supported by the specification of the above application, as filed. In particular, Applicants direct the Examiner’s attention to paragraph [0014] of the published version of the above application, which states:

If both surfaces of the web [10] are coated with the print receptive layer 14, 18, or 20, **then the holdout layer 12 is preferably applied to both surfaces of the web 10.**⁴

Web 10 of paragraph [0014] corresponds to the “base layer” in amended Claim 58. As also stated by paragraph [0014], holdout layer 12 may be “applied to both surfaces of the web 10,” and thus is in contact with each of the surfaces of the base layer according to amended Claim 58.

² All further references to the above application will be with respect to published U.S. Appln. No. 2004/0084163.

³ See pages 2-3 of the present Office Action (emphasis in the original).

⁴ Emphasis added.

Accordingly, in view of the amendments to Claim 58, the rejection of this Claim under 35 U.S.C. § 112, first paragraph, as failing to comply with the “written description” requirement is no longer supportable, and should therefore be withdrawn.

E. Response to Rejection of Claims 27-30, 33, 35, 37-39, 53-59, 63, and 65 under 35 U.S.C. § 103(a) as Being Unpatentable over Amick, in view of Malhotra

At pages 3-4 of the present Office Action, Claims 27-30, 33, 35,⁵ 37-39, 53-59, 63, and 65 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 99/63157 to Amick (hereafter referred to as “**Amick**”), taken in view of U.S. Pat. No. 5,709,976 to Malhotra (hereafter referred to as “**Malhotra**”). This rejection is respectfully traversed with respect to these Claims, as amended, for at least the following reasons.

In support of the rejection of Claims 27-30, 33, 35, 37-39, 53-59, 63, and 65 under 35 U.S.C. § 102(b) as being unpatentable over **Amick**, in view of **Malhotra**, the present Office Action makes the following allegation:

Allegation 2: [Amick] teaches a paper or paperboard with a basis weight such as 200 g/m² (=123 lb/3000 square feet) (3:7-26) and **a basecoat of starch or other materials**, with an ink-receptive layer on top that comprises acrylic polymers and additives such as polyvinyl alcohol (6:24-9:23). **The improved durability, resistance to staining and storageability are inherent to the coatings**. [Amick] fails to teach that the ink receiving layer has a biocide. [Malhotra] teaches a coated paper with a barrier layer and an ink receiving layer over the barrier layer that comprise[s] a biocide, as well as acrylic emulsions (see Abstract; 6:61-65; 12:1-6; 23:9-24:25). It would have been obvious [to] one of ordinary skill in the art to have added the biocide of the [Malhotra] ink receiving layer into the [Amick] paper because of the teaching of [Malhotra] that such a biocide is conventional in an acrylic containing ink receiving layer. [Amick] does not teach the water absorption range, **but because the coatings are similar to those claimed by [the] applicant, the water absorption range of the [Amick] paper or paper board are expected to overlap with that claimed by applicant**. The ink receptive layer is 0.5-10 g/m² (0.37-6.1 lb per 3000 sf) (4:13-22) which overlaps with the coat weight claimed by applicant.⁶

⁵ Claim 35 has now been cancelled so that the rejection of this Claim over **Amick**, in view of **Malhotra**, is now moot.

⁶ See pages 3-4 of the present Office Action (emphasis added).

Allegation 2 does not support the rejection of amended Claims 27-30, 33, 37-39, 53-59, 63, and 65 as being unpatentable over **Amick**, even in view of **Malhotra**, for at least the following reasons. First, Allegation 2 mischaracterizes Amick as teaching a “basecoat of starch or other materials.” Instead, what **Amick** actually teaches is “a basecoat containing mineral pigments.⁷ Starch is taught at line 20 of page 9 of this reference as one of many different “binders” for these mineral pigments in the “basecoat.”

By contrast, the holdout layer now recited in amended Claim 27 comprises a “starch sizing agent.⁸ As taught in paragraph [0014] of the above application, this starch sizing agent enables the claimed holdout layer to inhibit “penetration or absorption of the print [ink] receptive layer” into the base layer (i.e., web 10). Nowhere does **Amick** teach that its “basecoat containing mineral pigments” inhibits penetration or absorption of its ink receptive coating overlaying this “basecoat” into the “cellulosic fiber base stock.” In other words, the holdout layer of amended Claim 27 is not the same as “a basecoat containing mineral pigments” taught by **Amick**, and provides a functionality different property from that of the “basecoat” taught by this reference, i.e., inhibiting penetration or absorption of the ink receptive layer into the base layer.

Second, Allegation 2 proposes a modification of **Amick** based on the teachings of **Malhotra** that would impermissibly “change the principle of operation” of the **Amick** paper. “If the proposed modification or combination of prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.”⁸ While **Malhotra** teaches including a biocide in the “image receiving coating,” it also teaches that this “image receiving coating” is on top of a “hydrophobic barrier layer.” Nowhere does **Malhotra** teach that this “hydrophobic barrier layer” comprises a “mineral pigment” according to the “basecoat” of **Amick**. In addition, Allegation 2 cannot have it both ways by relying upon so much of **Malhotra** (i.e., “image receiving coating” which includes a biocide) as supports the proposed combination, but then ignoring those portions of this reference (“image receiving coating” is on top of a “hydrophobic barrier layer” from which a “mineral pigment” is absent) which teach away from the proposed combination.

⁷ See page 3, line 15, of **Amick** (emphasis added).

⁸ See, e.g., *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959); MPEP § 2143.01(VI) (emphasis added).

Third, Allegation 2 has not shown that all features of amended Claim 27 are taught by the references (i.e., **Amick** and **Malhotra**) relied upon. In determining patentability under 35 U.S.C. §103(a) over the art (i.e., the references relied upon in Allegation 2), all of the claim limitations (e.g., claim elements, features, etc.) must be considered.⁹ All of the features of amended Claim 27 are not taught or suggested by the combined references (**Amick** and **Malhotra**) for reasons previously presented above in response to Allegation 2. In mischaracterizing Amick as teaching a “basecoat of starch or other materials,” Allegation 2 fails to show where these combined references teach a holdout layer comprising a starch sizing agent according to amended Claim 27. In suggesting an impermissible modification of Amick based on the teachings of Malhotra, Allegation 2 also fails to show where these combined references teach a holdout layer comprising a starch sizing agent which is disposed between the base layer and an ink receptive layer comprising at least one biocide according to amended Claim 27. Put differently, this rejection of amended Claim 27 under 35 U.S.C. § 103(a) over **Amick**, in view of **Malhotra**, fails to satisfy at least one of the criteria for obviousness, namely that the prior art references must teach or suggest all the claim limitations (e.g., elements, features, etc.).

Fourth, Allegation 2 fails to allege any proper motivation for combining the teachings of **Malhotra** with those of **Amick**. To properly combine the teachings of **Malhotra** with those of **Amick**, the present Office Action must allege some proper motivation for one of ordinary skill in the art to do so.¹⁰ “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the prior art references themselves or in the knowledge generally available to one of ordinary skill in the art. This requirement is designed to protect against the tendency of using the Applicant’s disclosure in hindsight to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention.¹¹

In addition, “[a] proper analysis under 35 U.S.C. § 103 requires, inter alia, a consideration of two factors: (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed invention; and (2) whether the prior art would

⁹ See *In re Lowry*, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994).

¹⁰ See *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Kahn*, 78 U.S.P.Q.2d 1329, 1336 (Fed. Cir. 2006).

¹¹ See *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 21 USPQ2d 1941 (Fed. Cir. 1992) cited with approval by MPEP § 707.07(f) (emphasis added).

have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success; both the suggestion and reasonable expectation of success must be founded in the prior art, not the applicant's disclosure.¹² The suggestion, teaching or motivation to combine must be explicit, or at least implicit, in the references or other verifiable evidence provided by the Examiner relied upon to show such motivation.¹³ “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion obviousness.”¹⁴

The only motivation suggested by Allegation 2 for combining these references is that “the teaching of [Malhotra] that such a biocide is conventional in an acrylic containing ink receiving layer.” But contrary to the requirements 37 CFR § 1.104(c)(2),¹⁵ as well as to MPEP § 707.05,¹⁶ Allegation 2 does not properly address why one of ordinary skill in the art would be motivated based on what Amick teaches to modify the Amick paper as suggested. Put differently, and without improperly using Applicants' own disclosure in the present application as the road map,¹⁷ one of ordinary skill in the art would not combine Malhotra with Amick as suggested Allegation 2, much less according to amended Claim 27.

Amended Claims 28-30, 33, 37-39, 53-59, 63, and 65 depend from amended Claim 27. Accordingly, amended Claims 28-30, 33, 37-39, 53-59, 63, and 65 are patentable over Amick, even in view of Malhotra, for at least the same reasons amended Claim 27 is patentable over these combined references. Amended Claims 33, 37, 38, and 58 are further patentable over these combined references because of the features additionally recited in these Claims which are also not taught by these references: (a) “the paper or paperboard has a water absorption in the range of from about 30 to about 40 grams of water per square meter of paper or

¹² See *In re Vaeck*, 20 USPQ2d 1438, 1442-44 (Fed. Cir. 1991) (emphasis in original).

¹³ See e.g., *In re Kahn*, 78 U.S.P.Q.2d 1329, 1336 (Fed. Cir. 2006) (“A suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated by the references.”)

¹⁴ See e.g., *In re Kahn*, 78 U.S.P.Q.2d at 1336 (emphasis added).

¹⁵ 37 CFR § 1.104(c)(2) states, in relevant part, that: “The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.” (Emphasis added.)

¹⁶ MPEP § 707.05 (Citation of References) states, in relevant part, that: “When such prior art is cited, its pertinence should be explained.”

¹⁷ As the Federal Circuit held, in determining obviousness, it is improper hindsight reasoning to use an Applicant's own invention as a roadmap to find its prior art components.” See *Princeton Biochemicals Inc. v. Beckman Coulter Inc.*, 75 USPQ2d 1051, 1054 (Fed. Cir. 2005) (emphasis added).

paperboard as measured by a Cobb Sizing Test according to ASTM D-3285 (TAPPI T-441)” (amended Claim 33); (b) “a print layer” (amended Claim 37); (c) “a print layer disposed between the holdout layer and the ink receptive layer” (amended Claim 38); and (d) “the base layer comprises two surfaces and wherein the holdout layer contacts each of the two surfaces of the base layer” (amended Claim 58).

In fact, Allegation 2 admits that **Amick** “does not teach the water absorption range” of Claim 33. Instead, Allegation 2 asserts that “because the coatings are similar to those claimed by [the] applicant, the water absorption range of the [**Amick**] paper or paper board are expected to overlap with that claimed by applicant.” In other words, Allegation 2 relies upon an argument of “inherency” for this assertion. But this assertion of “inherency” regarding amended Claim 33 is factually unsupported and therefore contrary to the requirements of MPEP § 2112:

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.”¹⁸

Allegation 2 provides absolutely no facts or other verifiable evidence that the water absorption range of amended Claim 33 would “necessarily flow” from the paper/paperboard disclosed in **Amick**.

In response to Applicants argument in their prior February 26, 2009 Response that **Amick** is directed to “a coated paper,” the present Office Action makes the following additional allegation:

Allegation 3: The examiner disagrees. [**Amick**] states at 1:1-6 that the basestock may be coated or uncoated. The applicant has also argued that [**Malhotra**] teaches a coated paper. It is the examiner’s position that [**Malhotra**] is applied here for its teaching on the use of a biocide in an ink receiving layer.¹⁹

Because the rejected Claims no longer recite the term “uncoated,” Allegation 3 is now moot.

¹⁸ Ex parte Levy, 17 USPQ2d 1461, 1464 (BOPA 1990), which is cited with approval by MPEP § 2112 under the heading IV (EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY) (emphasis added).

¹⁹ See page 4 of the present Office Action.

If the Examiner still maintains that amended Claims 27-30, 33, 35, 37-39, 53-59, 63, and 65 are patentable over **Amick**, even in view of **Malhotra**, based on what Allegation 2 asserts, then Applicants alternatively assert that this rejection under 35 U.S.C. § 103(a) is based, at least partially, on facts within the Examiner's personal knowledge which have not been provided to Applicants. Accordingly, if the Examiner wishes to persist in this rejection of amended Claims 27-30, 33, 35, 37-39, 53-59, 63, and 65 as being patentable over **Amick**, even in view of **Malhotra**, under 35 U.S.C. § 102(b) for the reasons stated in Allegation 2, then Applicants respectfully request that she provide an affidavit/declaration under 37 CFR § 1.104(d)(2)²⁰ because this rejection appears to be based, at least partially, on facts within the Examiner's personal knowledge which have not been provided to Applicants, and which are not fairly taught by **Amick**, **Malhotra**, or any other verifiable evidence provided by the Examiner.

For at least the foregoing reasons, Claims 27-30, 33, 35, 37-39, 53-59, 63, and 65 are patentable over **Amick**, even in view of **Malhotra**. Accordingly, the rejection of these Claims under 35 U.S.C. § 102(b) as being unpatentable over these references should be withdrawn.

F. Response to Rejection of Claims 27-30, 33, 35, 37-39, 53-59, 63, and 65 under 35 U.S.C. § 103(a) as Being Unpatentable over Bailey

At pages 4-5 of the present Office Action, Claims 27-30, 33, 35,²¹ 37-39, 53-59, 63, and 65 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,885,340 to Bailey et al. (hereafter referred to as “**Bailey**”). This rejection is respectfully traversed with respect to these Claims, as amended, for at least the following reasons.

In support of the rejection of Claims 27-30, 33, 35, 37-39, 53-59, 63, and 65 under 35 U.S.C. § 102(b) as being unpatentable over **Bailey**, the present Office Action makes the following allegation:

²⁰ See 37 CFR § 1.104(d)(2) which states: “When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.” Applicants again note that in the unpublished case of *In re Sun*, 31 USPQ2d 1451, 1455 (Fed. Cir. 1993), the USPTO argued “the procedures established by 37 C.F.R. Section 1.107(b) (1993) [now 37 CFR § 1.104(d)(2)] *expressly entitle* an Applicant, on mere request, to an examiner affidavit that provides [citations that support the Examiner's asserted level of skill in the art]” (emphasis added). Furthermore, in *In re Sun*, the Federal Circuit, held that “this procedure, so readily available, helps save the lack of citation in an office action from possible constitutional infirmity in denying reasonable notice and hence due process.” See 31 USPQ2d at 1455.

²¹ Claim 35 has now been cancelled so that the rejection of this Claim over **Bailey** is now moot.

Allegation 4: [Bailey] teaches a printable paper or paperboard coated with a first layer that comprises starch, and second layer that comprises acrylic latex, biocide and other additives (see Abstract; 1:14-41; 2:18-56; 3:35-5:29; see Examples. Because the paper material may be paper board, it appear to meet the basis weight limitations [Bailey] does not teach the water absorption range, but because the coatings are similar to those claimed by applicant, the water absorption range of the [Bailey] paper or paperboard are expected to overlap with that claimed by applicant. The ink receptive layer is 0.5-10g/m² (0.37-6.1 lb per 300 sf) (4:13-22) which overlaps with the coat weight claimed by applicant.²²

Allegation 4 does not support the rejection of amended Claims 27-30, 33, 37-39, 53-59, 63, and 65 as being unpatentable over **Bailey** for at least the following reasons. First, Allegation 2 mischaracterizes what **Bailey** fairly teaches regarding what the second layer is and what that second layer may comprise. Specifically, the second layer of **Bailey** is formed from an “inorganic-pigment-containing aqueous coating composition.”²³ Also, and contrary to what Allegation 4 asserts, **Bailey** does not specifically teach that the second layer comprises an “acrylic latex” and a “biocide” and particularly the combination of an “acrylic latex” and “biocide” in the second layer.²⁴ More significantly, **Bailey** does not teach, and especially does not characterize, this second layer as an “ink receptive layer” according to amended Claim 27. In fact, and contrary to the requirements 37 CFR § 1.104(c)(2),²⁵ as well as to MPEP § 707.05,²⁶ Allegation 4 does not address why one of ordinary skill in the art would even consider the second layer of **Bailey** to be the “ink receptive layer” of amended Claim 27.

Second, Allegation 4 has not shown that all features of amended Claim 27 are taught by the reference (i.e., **Bailey**) relied upon. In determining patentability under 35 U.S.C. §103(a) over the art (i.e., the reference relied upon in Allegation 4), all of the claim limitations (e.g., claim elements, features, etc.) must be considered.²⁷ All of the features of amended Claim 27 are not taught or suggested by **Bailey** for reasons previously presented above in response to Allegation 4. In mischaracterizing what **Bailey** fairly teaches regarding composition and

²² See pages 4-5 of the present Office Action (emphasis added).

²³ See column 2, lines 25-27, of **Bailey**.

²⁴ See column 3, line 54 through column 5, line 6, of **Bailey**.

²⁵ 37 CFR § 1.104(c)(2) states, in relevant part, that: “The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.” (Emphasis added.)

²⁶ MPEP § 707.05 (Citation of References) states, in relevant part, that: “When such prior art is cited, its pertinence should be explained.”

²⁷ See *In re Lowry*, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994).

properties of the “second layer,” Allegation 4 fails to show where this reference teaches an ink receptive layer comprising at least one biocide according to amended Claim 27. Put differently, this rejection of amended Claim 27 under 35 U.S.C. § 103(a) over **Bailey** fails to satisfy at least one of the criteria for obviousness, namely that the prior art references must teach or suggest all the claim limitations (e.g., elements, features, etc.).

Amended Claims 28-30, 33, 37-39, 53-59, 63, and 65 depend from amended Claim 27. Accordingly, amended Claims 28-30, 33, 37-39, 53-59, 63, and 65 are patentable over **Bailey** for at least the same reasons amended Claim 27 is patentable over this reference. Amended Claims 33, 37, 38, 58, and 65 are further patentable over **Bailey** because of the features additionally recited in these Claims which are also not taught by this reference: (a) “the paper or paperboard has a water absorption in the range of from about 30 to about 40 grams of water per square meter of paper or paperboard” as measured by a Cobb Sizing Test according to ASTM D-3285 (TAPPI T-441)” (amended Claim 33); (b) “a print layer” (amended Claim 37); (c) “a print layer disposed between the holdout layer and the ink receptive layer” (amended Claim 38); (d) “the base layer comprises two surfaces and wherein the holdout layer contacts each of the two surfaces of the base layer” (amended Claim 58); and (e) “the ink receptive layer has a coat weight that is as little as 1.5 pounds per 3000 square feet” (amended Claim 65).

In fact, Allegation 4 admits that **Bailey** “does not teach the water absorption range” of Claim 33. Instead, Allegation 4 asserts that “because the coatings are similar to those claimed by applicant, the water absorption range of the [**Bailey**] paper or paperboard are expected to overlap with that claimed by applicant.” In other words, Allegation 4 relies upon an argument of “inherency” for this assertion. But this assertion of “inherency” regarding amended Claim 33 is factually unsupported and therefore contrary to the requirements of MPEP § 2112.²⁸ Allegation 4 provides absolutely no facts or other verifiable evidence that the water absorption range of amended Claim 33 would “necessarily flow” from the paper/paperboard disclosed in **Bailey**.

The reliance by Allegation 4 on the assertion that the “ink receptive layer is 0.5-10g/m² (0.37-6.1 lb per 300 sf) (4:13-22) which overlaps with the coat weight claimed by applicant” is

²⁸ See response to Allegation 2 above.

also misplaced. As pointed out above, nowhere does **Bailey** teach an “ink receptive layer” according to amended Claim 27. Accordingly, **Bailey** also cannot teach the ink receptive layer “coat weight” recited in amended Claim 65/

In response to Applicants argument in their prior February 26, 2009 Response that **Bailey** is directed to “a coated paper,” the present Office Action makes the following additional allegation:

Allegation 5: The examiner disagrees. [**Bailey**] teaches that each of the two coatings [are] applied to an unsized base paper (6:59-63).²⁹

Because the rejected Claims no longer recite the term “uncoated,” Allegation 5 is now moot.

If the Examiner still maintains that amended Claims 27-30, 33, 37-39, 53-59, 63, and 65 are patentable over **Bailey** based on what Allegation 4 asserts, then Applicants alternatively assert that this rejection under 35 U.S.C. § 103(a) is based, at least partially, on facts within the Examiner’s personal knowledge which have not been provided to Applicants. Accordingly, if the Examiner wishes to persist in this rejection of amended Claims 27-30, 33, 37-39, 53-59, 63, and 65 as being patentable over **Bailey** under 35 U.S.C. § 102(b) for the reasons stated in Allegation 4, then Applicants respectfully request that she provide an affidavit/declaration under 37 CFR § 1.104(d)(2)³⁰ because this rejection appears to be based, at least partially, on facts within the Examiner’s personal knowledge which have not been provided to Applicants, and which are not fairly taught by **Bailey**, or any other verifiable evidence provided by the Examiner.

²⁹ See page 5 of the present Office Action.

³⁰ See 37 CFR § 1.104(d)(2) which states: “When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.” Applicants again note that in the unpublished case of *In re Sun*, 31 USPQ2d 1451, 1455 (Fed. Cir. 1993), the USPTO argued “the procedures established by 37 C.F.R. Section 1.107(b) (1993) [now 37 CFR § 1.104(d)(2)] expressly entitle an Applicant, on mere request, to an examiner affidavit that provides [citations that support the Examiner’s asserted level of skill in the art]” (emphasis added). Furthermore, in *In re Sun*, the Federal Circuit, held that “this procedure, so readily available, helps save the lack of citation in an office action from possible constitutional infirmity in denying reasonable notice and hence due process.” See 31 USPQ2d at 1455.

For at least the foregoing reasons, Claims 27-30, 33, 37 -39, 53-59, 63, and 65 are patentable over **Bailey**. Accordingly, the rejection of these Claims under 35 U.S.C. § 102(b) as being unpatentable over this reference should be withdrawn.

G. Response to Rejection of Claims 60-62 under 35 U.S.C. § 103(a) as Being Unpatentable over Amick, Taken in view of Malhotra or Bailey, and Further Taken in view of Ghosh

At pages 5-6 of the present Office Action, Claims 60-26 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over **Amick**, in view of **Malhotra** or **Bailey**, and further in view of EP 880892 to Ghosh et al. (hereafter referred to as “**Ghosh**”). This rejection is respectfully traversed with respect to these Claims, as amended, for at least the following reasons.

In support of this rejection of Claims 60-62 as being unpatentable under 35 U.S.C. § 103(a) over **Amick**, in view of **Malhotra** or **Bailey**, and further in view of **Ghosh**, the present Office Action makes the following allegation:

Allegation 6: **[Amick]**, **[Malhotra]** and **[Bailey]** are all applied here for the reason given above. None of these references teach the biocides of claims 60-62. **[Ghosh]** teaches that 3-ido-2-propynyl butyl carbamate (4:25) is a microbiocide that may be used in paper coatings (5:8-19). It would have been obvious to one of ordinary skill in the art to have substituted the biocide of **[Malhotra]** or **[Bailey]** with the carbamate biocide of **[Ghosh]** with the expectation of success in controlling bacterial growth because of the teaching of **[Ghosh]** that 3-ido-2-propynyl butyl carbamate is a successful biocide for paper.³¹

Allegation 6 does not support the rejection of amended Claims 60-62 as being unpatentable over **Amick**, in view of **Malhotra** or **Bailey**, and further in view of **Ghosh**, for at least the following reasons. In determining patentability under 35 U.S.C. §103(a) over the art (*i.e.*, the references relied upon in Allegation 6), **all of the claim limitations** (e.g., claim elements, features, *etc.*) must be considered.³² **All of the features** of amended Claim 27 (from which amended Claims 60-62 depend) **are not taught or suggested** by **Amick**, **Malhotra**, or **Bailey** for reasons

³¹ See pages 5-6 of the present Office Action.

³² See *In re Lowry*, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994).

previously presented in response to Allegations 2 and 4 above. Allegation 6 only relies upon **Ghosh** to teach “that 3-iodo-2-propynyl butyl carbamate” is a “microbiocide that may be used in paper coatings,” but does not assert that **Ghosh** teaches any of the features of amended Claim 27 (from which amended Claims 60-62 depend)-which are missing from Amick, Malhotra, and Bailey.³³ Accordingly, amended Claims 60-62 are patentable over this combination of references for the same reasons that amended Claim 27 is patentable over this combination of references.

For at least the foregoing reasons, Claims 60-62 are patentable over **Amick**, even in view of **Malhotra** or **Bailey**, and even further in view of **Ghosh**. Accordingly, the rejection of these Claims under 35 U.S.C. § 103(a) over this combination of references should be withdrawn.

H. Conclusion

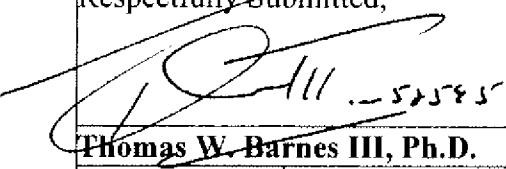
Claim 58, as amended, satisfies the requirements of 35 U.S.C. § 112, first paragraph, regarding “written description.”

Claims 27-30, 33, 37-39, 53-59, 63, and 65, as amended, are patentable over the art relied upon in the present Office Action. Accordingly, Claims 27-30, 33, 37-39, 53-59, 63, and 65 are in condition for allowance, and favorable action is earnestly solicited thereon.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Mr. Thomas W. Barnes, III at 513-248-6736 to expedite prosecution of the above application.

³³ Discussed above in response to Allegations 2 and 4.

Please charge the amount of **\$0.00** required for the request for extension of time to our Deposit Account No. 09-0525. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 09-0525. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time.

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